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09/873,850	06/04/2001	Robert V. Corteville	ROC920010080US1	4840

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EXAMINER

PUENTE, EMERSON C

ART UNIT

PAPER NUMBER

2113

DATE MAILED: 03/17/2004

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Please find below and/or attached an Office communication concerning this application or proceeding.

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**Office Action Summary**

Application No.

09/873,850

Applicant(s)

CORTEVILLE ET AL. *Sc*

Examiner

Emerson C Puente

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 04 June 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☐ Claim(s) \_\_\_\_\_ is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3 and 7-18 is/are rejected.
- 7) ☒ Claim(s) 4-6 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

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### DETAILED ACTION

This action is made Non-Final. Claims 1-18 have been examined.

#### *Claim Objections*

Claim 11 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim.

#### *Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-3, 10-11, and 18 are rejected under 35 U.S.C. § 103(a) as being unpatentable over US Patent No. 5,937,154 of Tegethoff in view of US Patent No. 6,336,195 of Shen et al. referred hereinafter "Shen".

In regards to claim 1, Tegetoff discloses:

providing a service processor coupled to a machine under test for sending system firmware test functions to said machine under test and receiving test data from said machine under test (see figure 4 items 42, 43 and see column 10 lines 25-30);

starting said system firmware test functions without user intervention on initial power-on routine of the machine under test (see column 9 lines 35-40);

However, Tegethoff fails to disclose:

providing a host computer coupled to said service processor for sending bring-up tool debug test functions to said machine under test and receiving test data from said machine under test

receiving a user request with said host computer and notifying said service processor; and starting said bring-up tool debug test functions responsive to said user request.

Shen discloses:

providing a host computer coupled to said service processor for sending bring-up tool debug test functions to said machine under test and receiving test data from said machine under test (see figure 2 item 130,132 and column 5 line 65 to column 6 lines 13)

receiving a user request with said host computer and notifying said service processor (see column 6 lines 1-13) ; and

starting said bring-up tool debug test functions responsive to said user request (see column 6 lines 9-13).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teaching of Tegethoff and Shen. A person of ordinary skill in the art would have been motivated to combine both teachings because Tegethoff discloses the test may include other test methods to complete a test suite (see column 14 lines 6-10) and providing a host computer coupled to said service processor for sending bring-up tool debug test functions to said machine under test and receiving test data from said machine under test, receiving a user request with said host computer and notifying said service processor, and starting said bring-up

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tool debug test functions responsive to said user request, as per teaching of Shen, constitutes as another test method to complete the test suite.

In regards to claim 2, Tegetoff discloses:

wherein the step of providing said service processor coupled to a machine under test for sending system firmware test functions to said machine under test and receiving test data from said machine under test includes the step of storing system firmware in said service processor for sending said system firmware test functions to said machine under test and receiving said test data from said machine under test by said service processor (see column 9 lines 35-40).

In regards to claim 3, Shen discloses:

wherein the step of providing said host computer coupled to said service processor for sending bring-up tool debug test functions to said machine under test and receiving test data from said machine under test includes the step of storing a bring-up tool in said host computer for sending bring-up tool debug test functions to said machine under test and receiving test data from said machine under test (see figure 2 item 132).

In regards to claim 10, Shen discloses:

completing said bring-up tool debug test functions (see column 6 lines 9-12)

In regards to claim 11, Tegethoff discloses:

starting said system firmware test functions without user intervention. (see column 9 lines 35-40).

In regards to claim 18, Tegethoff discloses

starting system firmware test functions without user intervention on initial power-on routine of the machine under test (see column 9 lines 35-40);

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sending system firmware test functions to said machine under test and receiving test data from said machine under test (see figure 4 items 42, 43 and see column 10 lines 25-30);

However, Tegethoff fails to disclose:

receiving a user request with said host computer and notifying said service processor; and

starting said bring-up tool debug test functions responsive to said user request; and

sending bring-up tool debug test functions to said machine under test and receiving test data from said machine under test.

Shen discloses:

receiving a user request with said host computer and notifying said service processor (see column 6 lines 1-13)

starting said bring-up tool debug test functions responsive to said user request (see column 6 lines 9-13); and

sending bring-up tool debug test functions to said machine under test and receiving test data from said machine under test (see figure 2 item 130,132 and column 5 line 65 to column 6 lines 13)

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teaching of Tegethoff and Shen. A person of ordinary skill in the art would have been motivated to combine both teachings because Tegethoff discloses the test may include other test methods to complete a test suite (see column 14 lines 6-10) and receiving a user request with said host computer and notifying said service, starting said bring-up tool debug test functions responsive to said user request, and sending bring-up tool debug test functions to

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said machine under test and receiving test data from said machine under test, as per teaching of Shen, constitutes as another test method to complete the test suite.

Claims 7-9 and 12-17 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Tegethoff in view of Shen and in further view of US Patent No. 6,647,511 of Swoboda et al. referred hereinafter "Swoboda".

In regards to claim 7, Tegethoff in view of Shen fails to disclose:

providing said service processor with a scan controller coupled to said machine under test and said system firmware test functions and said bring-up tool debug test functions controlling access to the scan controller.

However, Swoboda discloses a scan controller used to serially translate serial bit patterns and provide the bit patterns to the emulator (see column 3 lines 4-13).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide said service processor with a scan controller coupled to said machine under test and said system firmware test functions and said bring-up tool debug test functions controlling access to the scan controller. A person of ordinary skill in the art at the time the invention was made would have been motivated to make the modification because Tegethoff discloses the computing system probe connected to the emulator debug hardware of the computing system under test via a serial port (see column 8 lines 5-10 and 24-30), indicating a serial connection, and a scan controller, as per teaching of Swoboda, provides a means to serially translate and transmit data to the emulator debug hardware of the computing system under.

In regards to claim 8, Tegethoff discloses:

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storing system firmware in said service processor for controlling said scan controller for sending said system firmware test functions to said machine under test and receiving said test data from said machine under test by said service processor (see column 9 lines 35-40).

In regards to claim 9, Shen discloses:

storing a bring-up tool in said host computer for controlling said scan controller for sending bring-up tool debug test functions to said machine under test and receiving test data from said machine under test (see figure 2 item 130,132 and column 5 line 65 to column 6 lines 13)

In regards to claim 12, Tegetoff discloses:

a service processor coupled to a machine under test for sending system firmware test functions to said machine under test and receiving test data from said machine under test (see figure 4 items 42, 43 and see column 10 lines 25-30);

However, Tegethoff fails to disclose:

a host computer coupled to said service processor for sending bring-up tool debug test functions to said machine under test and receiving test data from said machine under test;

said service processor including a scan controller for transferring said system firmware test functions and said bring-up tool debug test functions to said machine under test and receiving said test data from said machine under test; and said system firmware test functions and said bring-up tool debug test functions controlling access to said scan controller.

Shen discloses:



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a host computer coupled to said service processor for sending bring-up tool debug test functions to said machine under test and receiving test data from said machine under test (see figure 2 item 130, 132 and column 5 line 65 to column 6 line 13);

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teaching of Tegethoff and Shen. A person of ordinary skill in the art would have been motivated to combine both teachings because Tegethoff discloses the test may include other test methods to complete a test suite (see column 14 lines 6-10) and receiving a user request with said host computer and notifying said service, starting said bring-up tool debug test functions responsive to said user request, and sending bring-up tool debug test functions to said machine under test and receiving test data from said machine under test, as per teaching of Shen, constitutes as another test method to complete the test suite.

Furthermore, Swoboda discloses a scan controller used to serially translate serial bit patterns and provide the bit patterns to the emulator (see column 3 lines 4-13).

It would have been obvious to one of ordinary skill in the art at the time the invention wherein said service processor including a scan controller for transferring said system firmware test functions and said bring-up tool debug test functions to said machine under test and receiving said test data from said machine under test and said system firmware test functions and said bring-up tool debug test functions controlling access to said scan controller. A person of ordinary skill in the art at the time the invention was made would have been motivated to make the modification because Tegethoff discloses the computing system probe connected to the emulator debug hardware of the computing system under test via a serial port (see column 8 lines 5-10 and 24-30), indicating a serial connection, and a scan controller, as per teaching of

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Swoboda, provides a means to serially translate and transmit data to the emulator debug hardware of the computing system under.

In regards to claim 13, Swoboda discloses

wherein said scan controller is coupled to said machine under test by a JTAG bus (see column 3 lines 5-10).

In regards to claim 14, Shen discloses

wherein said host computer coupled to said service processor includes system firmware for providing a graphical user interface (see figure 2 item 134).

In regards to claim 15, Shen discloses

wherein said host computer is responsive to a user request for sending bring-up tool debug test functions to said machine under test and receiving test data from said machine under test (see column 6 lines 1-13).

In regards to claim 16, Tegethoff discloses

wherein said service processor is responsive to an initial power-on routine of the machine under test for sending system firmware test functions to said machine under test and receiving test data from said machine under test without user intervention (see column 9 lines 35-40).

In regards to claim 17, Tegethoff discloses

wherein said service processor is responsive to said bring-up tool debug test functions completing for sending system firmware test functions to said machine under test and receiving test data from said machine under test without user intervention (see figure 4 items 42, 43 and see column 10 lines 25-30).

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***Allowable Subject Matter***

Claims 4-6 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

See Form PTO-892.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Emerson C Puente whose telephone number is (703) 305-8012. The examiner can normally be reached on 8-5 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert W Beausoliel can be reached on (703) 305-9713. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 306-5631.

***Emerson Puente***  
3/14/04

  
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